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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,436

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Sabrina John

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EXAMINER

HOFFMAN, SUSAN COE

ART UNIT

PAPER NUMBER

1655

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/584,436	<b>Applicant(s)</b> JOHN, SABRINA	
	<b>Examiner</b> Susan Coe Hoffman	<b>Art Unit</b> 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008 and 26 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-18 is/are pending in the application.
- 4a) Of the above claim(s) 8-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1-07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The amendment filed March 17, 2008 has been received and entered.
2. Claims 3-18 are currently pending.

### ***Election/Restrictions***

3. Applicant's election without traverse of group I, claims 3-7, in the reply filed on December 26, 2007 is acknowledged.
4. Claims 8-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 26, 2007.

### ***Oath/Declaration***

5. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration.

### ***Specification***

6. The disclosure is objected to because of the following informalities: it does not contain a brief description of the drawings.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treatment and reduction of hyperpigmentation or hypopigmentation, does not reasonably provide enablement for prevention of hyperpigmentation or hypopigmentation. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Undue experimentation would be required to practice the invention as claimed due to the quantity of experimentation necessary; limited amount of guidance and limited number of working examples in the specification; nature of the invention; state of the prior art; relative skill level of those in the art; predictability or unpredictability in the art; and breadth of the claims. In re Wands, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Applicant's claims are broadly drawn to a method of preventing hyperpigmentation or hypopigmentation using a composition comprising *Bellis perennis*. "Prevention" is considered to be an absolute term which requires prevention of a condition in each and every instant of that condition. Applicant's specification does not show that *B. perennis* application is able to prevent the claimed hyper- and hypopigmentations. The specification only shows that the *B. perennis* is able to inhibit the production of melanin but not prevent the underlying causes that lead to hyper- and hypopigmentation. In addition, in discussing hyperpigmentation, the art teaches that prevention of hyperpigmentation such as sun and age spots cannot be entirely achieved (see

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<http://beauty.ivillage.com/skinbody/facecare/0,,rf9x-p,00.html>). Furthermore, the art also

teaches that hypopigmentation such as vitiligo cannot be prevented (see

<http://www.healthatoz.com/healthatoz/Atoz/common/standard/transform.jsp?requestURI=/healthatoz/Atoz/ency/vitiligo.jsp>). Thus, since the specification does not show prevention and the state

of the art acknowledges that prevention is not possible, an artisan would be forced to experiment unduly to determine if the claimed method is able to function as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 is considered indefinite due to the use of parentheses. Parentheses in this case are considered indefinite because it is unclear if the enclosed limitation is a required limitation in the claim. Claim 4 is also indefinite because the definition of "tenside" is unclear.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 07025762 (English translation provided).

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JP '762 teaches a method for depigmenting skin using a composition comprising an extract of *B. perennis*. The reference teaches using the method to treat pigmented stains and spots, freckles, and damage caused by the sun. The composition is formulated into a cream, lotion, ointment, or milky lotion. The composition also contains additional depigmenting agents such as kojic acid, anti-inflammatory agents, anti-oxidants, and surfactants (see paragraphs 25, 2-8, 34 and 35 of the translation).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07025762.

The teachings of this reference are discussed above. The reference does not specifically teach formulating the composition into all of the compositions claimed by applicant in claim 3. However, these are all well known cosmetically acceptable forms. An artisan of ordinary skill would be motivated to employ these well known forms while making the cosmetic composition taught by JP '762.

The reference also does not specifically teach using the *B. perennis* in the amounts claimed by applicant. However, the reference does teach using active ingredients in amounts from 0.001% to 10% (see paragraph 32 of the translation). Therefore, an artisan of ordinary skill

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would reasonably expect that using concentrations of *B. perennis* within these percentages would be useful in the depigmenting method taught by the reference. This reasonable expectation of success would motivate the artisan to use these concentrations of *B. perennis* to depigment the skin.

In addition, the reference does not specifically teach treating all of the type of hyperpigmentation claimed by applicant. However, these are well known types of hyperpigmentation. An artisan of ordinary skill would reasonably expect that known depigmenting agent could be used to treat these types of hyperpigmentation. This reasonable expectation of success would motivate the artisan to use the *B. perennis* depigmenting method taught by JP '762 to treat these types of hyperpigmentation.

11. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07025762 in view of Charpin (US 5,164,185).

The teachings of JP '762 are discussed above. The reference does not specifically teach using the *B. perennis* to treat hypopigmentation as claimed. However, Charpin teaches that it was known in the art at the time of the invention to use depigmenting agents to treat hypopigmentation. The reference teaches that the depigmenting agents are useful to even out the color of the skin by depigmenting the normal skin that is not effected by the hypopigmentation. Thus, an artisan of ordinary skill would have reasonably expected that the depigmenting method taught by JP '762 would be useful in treating the hypopigmentations claimed by applicant. This reasonable expectation of success would motivate the artisan to modify JP '762 to include treatment of hypopigmentation.

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12. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe Hoffman whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday-Thursday, 9:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Coe Hoffman/  
Primary Examiner, Art Unit 1655